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**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY**

TELECOMMUNICATIONS RESEARCH )  
LABORATORIES d/b/a TR LABS AND )  
TR TECHNOLOGIES, INC. )  
 )  
Plaintiffs, )  
 )  
v. ) Civ. No. 3:09-cv-3883(PGS)(DEA)  
 )  
 )  
AT&T CORP., ) ELECTRONICALLY FILED  
 )  
Defendant. )

**TR LABS' SUR-REPLY TO AT&T'S MOTION FOR PARTIAL SUMMARY  
JUDGMENT OF PATENT EXHAUSTION**

AT&T has cited *LifeScan Scotland, Ltd. v. Shasta Technologies, LLC*, which has virtually nothing in common with the instant case. LifeScan, the patentee, manufactured blood glucose meters. *LifeScan Scotland, Ltd. v. Shasta Technologies*,

LLC, 2013 U.S. App. LEXIS 22332 \*3-4 (Fed. Cir. Nov. 4, 2013). Shasta, the accused infringer, made blood glucose test strips used with LifeScan's meters. *Id.* at \*6. LifeScan sued Shasta for indirect infringement, alleging that Shasta's customers using test strips in conjunction with LifeScan's meters were direct infringers. *Id.* Shasta asserted patent exhaustion. *Id.* at \*7. This is far different than TR Labs' offer of a covenant not to sue against Cisco against whom TR Labs admittedly had neither a claim for direct or indirect infringement.

AT&T cites *LifeScan* for the proposition that a potential non-infringing use will not prevent exhaustion where the use in question is the “very use contemplated by the patented invention itself.” *Id.* at \*17. While that may be true, the substantial non-infringing use for Cisco's components is, *e.g.*, in a SONET ring, a use not contemplated by the '734 and '059 patents identified by AT&T.

This Court construed “straddling span” in the '734 patent as, *inter alia*, extending “between two nodes on a preconfigured cycle . . . but is not part of the preconfigured cycle of spare capacity,” *i.e.*, a “mesh” configuration. *See* ECF No. 116 at 28. The Court also stated that that the '059 patent is directed to “converting a ring network to a ***mesh*** network.” *Id.* at 34 (emphasis added). Thus, the use of Cisco's components in a ring configuration cannot infringe either of these patents, and such use is not “contemplated” by either patent. Consequently, the *LifeScan* decision does not warrant the application of the patent exhaustion doctrine here.

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Respectfully submitted,

s/ Kristine L. Butler

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